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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT 1615	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/656,134

Applicant(s)

DE LA POTERIE ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-61 is/are pending in the application.
- 4a) Of the above claim(s) 57-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/1/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of election, IDS and preliminary amendment filed on 2/5/07, 3/1/04 and 9/8/03 respectively.

The preliminary amendment canceled claims 1-30 and added claims 31-61. Claims 31-61 are pending in the application and the status of the application is as follows:

#### ***Election/Restrictions***

Applicant's election with traverse of group I in the reply filed on 2/5/07 is acknowledged. The traversal is on the ground(s) that the search for the compositions and methods would occur in the same classes/subclasses given the fact that the compositions in Group I compositions are essentially the same compositions used in the Group II and III methods and the same classes/subclasses would be searched because the same compositions are relevant to Group I, Group II and Group III claims -- no burden would be placed on the Office in searching and/or examining all claims together since Group II and III method claims depend from the Group I composition claims and pursuant to MPEP § 821.04, such dependent method claims should be rejoined in this application upon indication of allowable subject matter. This is not found persuasive because the restriction between composition and method of uses is in compliance with MPEP § 806.05(h) and it is a search burden to examine all the groups in group I particularly when the claims are so broad that the search for one distinct invention is already of sufficient burden. Moreover, the composition of claim 1 is readable on pesticides or herbicides or cleansing compositions or fragrance compositions, majority of which are classified in classes 504, 514, 510 and 511. With respect to applicant argument that possible rejoinder of method claims makes the restriction at this time unnecessary, it is the position of the examiner that none of the

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composition claims are allowable. The requirement is still deemed proper and is therefore made FINAL.

With respect to election of species applicants' elect the specie of semi-crystalline polymers, particularly stearyl acrylate-N vinylpyrrolidone and traverse the election of species. The traversal is on the ground(s) that the different structuring agents as being patentably distinct is not explained in sufficient detail or by example, and as such represents only a conclusion, particularly in view of the fact that the identified species are related by operation and/or effect. Accordingly, division of each of these species is unsupported and improper. See, MPEP §§ 802.01 and 806.04 (b). This is not found persuasive because there is no common core between the structuring agents. The structuring agent can be semi-crystalline polymer or it can be fatty-phase rheological agents. The specification describes the semi-crystalline polymer. See below for the various species.

IN ACCORDANCE WITH THE INVENTION THE SEMI-crystalline polymer may be selected from block copolymers containing at least one crystallizable block and at least one amorphous block, homopolymers and copolymers carrying at least one crystallizable side chain per repeating unit, and mixtures thereof.

The semi-crystalline polymers which can be used in the invention are in particular:

- block polyolefin copolymers of controlled crystallization, particularly those whose monomers are described in EP-A-0 951 897,

- polycondensates, particularly those of aliphatic or aromatic polyester type or aliphatic/aromatic copolyester type,

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- homopolymers or copolymers carrying at least one crystallizable side chain and homopolymers or copolymers carrying in the skeleton at least one crystallizable block, such as those described in US-A-5 156 911,

- homopolymers or copolymers carrying at least one crystallizable side chain, in particular containing one or more fluorine-containing groups, such as those described in WO-A-01/19333,

- and mixtures thereof.

In these two latter cases the crystallizable side chain(s) or block(s) are hydrophobic.

A) Semi-crystalline polymers having crystallizable side chains

Mention may be made in particular of those defined in US-A-5,156,911 and WO-A-01/19333. These are homopolymers or copolymers containing from 50 to 100% by weight of units resulting from the polymerization of one or more monomers which carry a crystallizable hydrophobic side chain.

- These homopolymers or copolymers are of any kind, provided that they meet the conditions indicated above.

They may result

- from the polymerization, in particular the free-radical polymerization, of one or more monomers containing reactive or ethylenic double bond(s) in respect of a polymerization, namely containing a vinylic (meth)acrylic or allylic group;

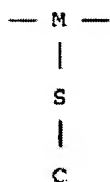
- from the polycondensation of one or more monomers which carry co-reactive groups (carboxylic or sulphonic acid, alcohol, amine or isocyanate), such as, for example, polyesters, polyurethanes, polyethers, polyureas and polyamides.

Generally speaking these polymers are selected in particular from homopolymers and copolymers resulting from the polymerization of at least one

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crystallizable-chain monomer which can be representable of formula X:



with M representing an atom of the polymeric skeleton, S representing a spacer and C representing a crystallizable group.

The crystallizable chains "-S-C" may be aliphatic or aromatic, optionally fluorinated or perfluorinated. "S" represents in particular a  $(\text{CH}_2)_n$  or  $(\text{CH}_2\text{CH}_2\text{O})_n$  or  $(\text{CH}_2\text{O})$  group which is linear or branched or cyclic, with n being an integer ranging from 0 to 22. "S" is preferably a linear group. Preferably "S" and "C" are different.

When the crystallizable chains "-S-C" are aliphatic hydrocarbon chains they contain alkyl hydrocarbon chains containing at least 11 carbon atoms and not more than 40 carbon atoms, and better still not more than 24 carbon atoms. They are in particular aliphatic chains or alkyl chains possessing at least 12 carbon atoms and preferably the chains in question are  $\text{C}_{14}$ - $\text{C}_{24}$  alkyl chains. When the chains in question are fluorinated or perfluorinated alkyl chains they contain at least 6 fluorinated carbon atoms and in particular at least 11 carbon atoms of which at least 6 carbon atoms are fluorinated.

Examples of semi-crystalline polymers or copolymers containing one or more crystallizable chains include those resulting from the polymerization of one or more monomers as follows: saturated alkyl (meth)acrylates with the  $\text{C}_{14}$ - $\text{C}_{24}$  alkyl group, perfluoroalkyl (meth)acrylates with a  $\text{C}_{11}$ - $\text{C}_{25}$  perfluoroalkyl group, N-alkyl(meth)acrylamides with the  $\text{C}_{14}$  to

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C<sub>14</sub> alkyl group with or without a fluorine atom, vinyl esters containing alkyl or perfluoro(alkyl) chains with the C<sub>14</sub> to C<sub>24</sub> alkyl group (with at least 6 fluorine atoms for a perfluoroalkyl chain, vinyl ethers containing alkyl or perfluoro(alkyl) chains with the C<sub>14</sub>-C<sub>24</sub> alkyl group and at least 6 fluorine atoms for a perfluoroalkyl chain, C<sub>14</sub> to C<sub>24</sub> alpha-olefins such as, for example, octadecene, para-alkylstyrenes with an alkyl group containing 12 to 24 carbon atoms, and mixtures thereof.

When the polymers result from a polycondensation the hydrocarbon and/or fluorinated crystallizable chains as defined above are carried by a monomer which may be a diacid, a diol, a diamine or a diisocyanate.

When the polymers of the invention are copolymers they also include from 0 to 50% of groups Y or Z resulting from the copolymerization

a) of Y, which is a polar or non-polar monomer or a mixture of the two:

- when Y is a polar monomer it is either a monomer which carries polyoxyalkylenated groups (especially oxyethylenated and/or oxypropylenated), a hydroxyalkyl (meth)acrylate such as hydroxyethyl acrylate, (meth)acrylamide, an N-alkyl(meth)acrylamide, an N,N-dialkyl(meth)acrylamide such as, for example, N,N-diisopropylacrylamide or N-vinylpyrrolidone (NVP), N-vinylcaprolactam, a monomer which carries at least one carboxylic acid group such as (meth)acrylic, crotonic, itaconic, maleic or fumaric acid or which carries a carboxylic anhydride group such as maleic anhydride, and mixtures thereof.

- When Y is a non-polar monomer it may be an ester of the linear, branched or cyclic alkyl (meth)acrylate type, a vinyl ester, an alkyl vinyl ether, an alpha-olefin, styrene or styrene substituted by a C<sub>1</sub> to C<sub>10</sub> alkyl group, such as  $\alpha$ -methylstyrene or a

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polyorganosiloxane-type macromonomer containing vinylic unsaturation.

"Alkyl" for the purposes of the invention is a saturated group, in particular a  $C_8$  to  $C_{24}$  group, unless specifically mentioned, and better still a  $C_{14}$  to  $C_{24}$  group.

$\beta$ ) of Z, which is a polar monomer or a mixture of polar monomers. In this case Z has the same definition as "polar Y" defined above.

Semi-crystalline polymers containing a crystallizable side chain are preferably alkyl (meth)acrylate or alkyl(meth)acrylamide homopolymers with an alkyl group as defined above, and in particular  $C_{14}$ - $C_{24}$  group, copolymers of these monomers with a hydrophilic monomer, preferably of a different kind from (meth)acrylic acid, such as N-vinylpyrrolidone, or hydroxyethyl (meth)acrylate, and mixtures thereof.

B) Polymers carrying in the skeleton at least one crystallizable block

These polymers are, in particular, block copolymers consisting of at least 2 chemically different blocks of which one is crystallizable.

- It is possible to use the block polymers defined in patent US-A-5,156,911 ;

- block copolymers of olefin or of cycloolefin containing a crystallizable chain, such as those obtained from the block polymerization of :

• cyclobutene, cyclohexene, cyclooctene, norbornene (i.e. bicyclo[2.2.1]hept-2-ene), 5-methylnorbornene, 5-ethylnorbornene, 5,6-dimethylnorbornene, 5,5,6-trimethylnorbornene, 5-ethylidenenorbornene, 5-phenylnorbornene, 5-benzylnorbornene, 5-vinylnorbornene, 1,4,5,8-dimethano-1,2,3,4,4a,5,8a-octahydronaphthalene, dicyclopentadiene or mixtures thereof



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- with ethylene, propylene, 1-butene, 3-methyl-1-butene, 1-hexene, 4-methyl-1-pentene, 1-octene, 1-decene, 1-eicosene or mixtures thereof,

- and in particular block copoly(ethylene/norbornene) and block (ethylene/propylene/ethylidene-norbornene) terpolymers. It is also possible to use those resulting from the block copolymerization of at least two  $C_2-C_{16}$  and better still  $C_2-C_{12}$  and even better still  $C_4-C_{12}$   $\alpha$ -olefins, such as those mentioned above, and in particular the block bipolymers of ethylene and of 1-octene.

- The copolymers may be copolymers having at least one crystallizable block, the remainder of the copolymer being amorphous (at ambient temperature). These copolymers may further comprise two chemically different crystallizable blocks. Preferred copolymers are those which possess at ambient temperature both a crystallizable block and an amorphous block which is both hydrophobic and lipophilic, the blocks being distributed sequentially; mention may be made, for example, of polymers possessing one of the following crystallizable blocks and one of the following amorphous blocks:

- Naturally crystallizable blocks: a) polyesters such as poly(alkylene terephthalate), b) polyolefins such as polyethylenes or polypropylenes.

- Amorphous and lipophilic block, such as amorphous polyolefins or copoly(olefin)s such as poly(isobutylene), hydrogenated polybutadiene and hydrogenated poly(isoprene).

Possible examples of such copolymers containing a crystallizable block and an amorphous block, the blocks being distinct, include:

$\alpha$ ) block poly( $\epsilon$ -caprolactone)-b-poly(butadiene) copolymers, used preferably in hydrogenated form, such as those described in the article "Melting behavior of

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poly( $\epsilon$ -caprolactone)-block-polybutadiene copolymers" by S. Nojima, *Macromolécules*, 32, 3727-3734 (1999).

$\beta$ ) hydrogenated poly(butylene terephthalate)-b-poly(isoprene) block or multiblock copolymers, cited in the article "Study of morphological and mechanical properties of PP/PBT" by B. Boutevin et al., *Polymer Bulletin*, 34, 117-123 (1995).

$\gamma$ ) the poly(ethylene)-b-copoly(ethylene/-propylene) block copolymers cited in the articles "Morphology of semi-crystalline block copolymers of ethylene-(ethylene-alt-propylene)" by P. Rangarajan et al., *Macromolecules*, 26, 4640-4645 (1993) and "Polymer aggregates with crystalline cores: the system poly(ethylene)-poly(ethylene-propylene)" by P. Richter et al., *Macromolécules*, 30, 1053-1068 (1997).

$\delta$ ) the poly(ethylene)-b-poly(ethylethylene) block copolymers cited in the general article "Crystallization in block copolymers" by I.W. Hamley, *Advances in Polymer Science*, Vol. 148, 113-137 (1999).

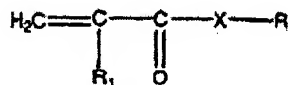
The semi-crystalline polymers of the composition of the invention may be non-crosslinked or partially crosslinked, since the degree of crosslinking is not detrimental to their dissolution or dispersion in the liquid fatty phase by heating above their melting point. This may then be a chemical crosslinking, by reaction with a polyfunctional monomer during the polymerization. It may also be a physical crosslinking, which may then be due either to the establishment of bonds of hydrogen type or dipolar type between groups carried by the polymer, such as, for example, the dipolar interactions between carboxylate ionomers, these interactions being low in quantity and borne by the polymer skeleton; or due to phase

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separation between the crystallizable blocks and the amorphous blocks carried by the polymer.

The semi-crystalline polymers of the composition according to the invention are preferably non-crosslinked.

According to one particular embodiment of the invention the polymer is selected from copolymers resulting from the polymerization of at least one monomer containing a crystallizable chain, selected from saturated  $C_{14}$  to  $C_{24}$  alkyl (meth)acrylates,  $C_{11}$  to  $C_{15}$  perfluoroalkyl (meth)acrylates,  $C_{14}$  to  $C_{24}$  N-alkyl-(meth)acrylamides with or without a fluorine atom, vinyl esters containing  $C_{14}$  to  $C_{24}$  alkyl or perfluoroalkyl chains, vinyl ethers containing  $C_{14}$  to  $C_{24}$  alkyl or perfluoroalkyl chains,  $C_{14}$  to  $C_{24}$   $\alpha$ -olefins, para-alkylstyrenes with an alkyl group containing 12 to 24 carbon atoms, with at least one optionally fluorinated  $C_1$  to  $C_{10}$  monocarboxylic ester or amide, which can be represented by the following formula:



in which  $R_1$  is H or  $\text{CH}_3$ , R represents an optionally fluorinated  $C_1$ - $C_{10}$  alkyl group and X represents O, NH or  $\text{NR}_2$ , where  $R_2$  represents an optionally fluorinated  $C_1$ - $C_{10}$  alkyl group.

According to one more particular embodiment of the invention the polymer is derived from a monomer containing a crystallizable chain, selected from saturated  $C_{14}$  to  $C_{22}$  alkyl (meth)acrylates.

As a specific example of a structuring semi-crystalline polymer that can be used in the composition according to the invention, mention may be made of the Interlimer® products from Landec which are described in the brochure "Interlimer® polymers", Landec IP22 (Rev. 4-97). These polymers are in solid form at

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ambient temperature (25°C). They carry crystallizable side chains and have the above formula X.

The semi-crystalline polymers may in particular be:

those described in Examples 3, 4, 5, 7, 9 and 13 of patent US-A-5,156,911 containing a -COOH group, resulting from the copolymerization of acrylic acid and C<sub>5</sub> to C<sub>16</sub> alkyl (meth)acrylate, and more particularly from the copolymerization

- of acrylic acid, hexadecyl acrylate and isodecyl acrylate in a 1/16/3 weight ratio,
- of acrylic acid and pentadecyl acrylate in a 1/19 weight ratio,
- of acrylic acid, hexadecyl acrylate and ethyl acrylate in a 2.5/76.5/20 weight ratio,
- of acrylic acid, hexadecyl acrylate and methyl acrylate in a 5/85/10 weight ratio,
- of acrylic acid and octadecyl methacrylate in a 2.5/97.5 weight ratio,
- of hexadecyl acrylate, polyethylene glycol methacrylate monomethyl ether containing 8 ethylene glycol units, and acrylic acid in an 8.5/1/0.5 weight ratio.

It is also possible to use the polymer having the structure "O" from National Starch, as described in US-A-5,736,125, with a melting point of 44°C, and also semi-crystalline polymers containing crystallizable pendant chains containing fluorinated groups, as described in Examples 1, 4, 6, 7 and 8 of WO-A-01/19333.

It is additionally possible to use the semi-crystalline polymers obtained by copolymerizing stearyl acrylate and acrylic acid or NVP, as described in US-A-5 519 063 or EP-A-550745, with melting points of 40°C and 38°C respectively.

Thus from the above description; there are plethoras of polymers, which can be homopolymers and copolymers. It is indeed a search burden to examine all these polymers in the composition of group I since they include classes 525-527.

See below for description of **fatty-phase rheological agents**.

This rheological agent is advantageously selected from lipophilic gelling agents, organic gellers and mixtures thereof.

The lipophilic gelling agent may be organic or mineral, polymeric or molecular.

As inorganic lipophilic gelling agent mention may be made of optionally modified clays, such as hectorites modified with a  $C_{10}$  to  $C_{22}$  fatty acid ammonium chloride, such as hectorite modified with distearyldimethylammonium chloride.

Mention may also be made of optionally surface-hydrophobicized pyrogenic silica whose particle size is less than 1  $\mu m$ . It is possible in effect to modify chemically the surface of the silica, by a chemical reaction which brings about a decrease in the number of silanol groups present on the surface of the silica. In particular it is possible to substitute the silanol groups by hydrophobic groups: in that case a hydrophobic silica is obtained. The hydrophobic groups may be

- trimethylsiloxyl groups, obtained in particular by treating pyrogenic silica in the presence

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of hexamethyldisilazane. Silicas treated in this way are named "silica silylate" according to the CTFA (6th edition, 1995). They are sold, for example, under the names Aerosil R812<sup>®</sup> by Degussa and CAB-O-SIL TS-530<sup>®</sup> by Cabot.

- dimethylsilyloxy or polydimethylsiloxane groups, obtained in particular by treating pyrogenic silica in the presence of polydimethylsiloxane or dimethyldichlorosilane. Silicas treated in this way are named "silica dimethyl silylate" according to the CTFA (6th edition, 1995). They are sold for example under the names Aerosil R972<sup>®</sup>, Aerosil R974<sup>®</sup> by Degussa and CAB-O-SIL TS-610<sup>®</sup> and CAB-O-SIL TS-720<sup>®</sup> by Cabot.

The hydrophobic pyrogenic silica preferably has a particle size which can be nanometric to micrometric, ranging for example from 5 to 200 nm approximately.

The polymeric organic lipophilic gelling agents are, for example, partly or completely crosslinked elastomeric organopolysiloxanes of three-dimensional structure, such as those sold under the names KSG6, KSG16 and KSG18 by Shin-Etsu, Trefil E-505C or Trefil E-506C by Dow-Corning, Gransil SR-CYC, SR DMF10, SR-DC556, SR 5CYC gel, SR DMF 10 gel, SR DC 556 gel from Grant Industries, SF 1204 and JK 113 by General Electric; ethylcellulose such as those sold under the name Ethocel by Dow Chemical; polyamides such as copolymers of a C<sub>16</sub> diacid condensed with ethylenediamine, with a weight-average molecular mass of approximately 6000, such as the compounds sold by Arizona Chemical under the names Uniclear 80 and Uniclear 100, gums, especially silicone gums, such as PDMS having a viscosity > 100 000 centistokes, galactomannans containing from one to six and better still from two to four hydroxyl groups per saccharide unit, substituted by a saturated or unsaturated alkyl chain, such as guar gum alkylated with C<sub>1</sub> to C<sub>6</sub> alkyl chains and better still C<sub>1</sub> to C<sub>3</sub> alkyl chains, and mixtures thereof.

Thus from the above description both the classes of structuring agents are drawn to divergent compounds and the species are distinct and separate and it is a search burden to examine all the species in either category in group I compositions.

Claims 57-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/5/07.

Claims 31-56 are pending in the application and then independent claims are examined to the extent that it reads on the elected species belonging to semi-crystalline polymer, which is stearyl acrylate-N-vinyl pyrrolidone.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 54-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression “care composition” lacks clarity and it is unclear as to applicants’ intent. Specification fails to define the meaning for “care composition”.

What does making up eyelashes mean? Is it makeup for eyelashes? If it is makeup for eyelash, is it mascara or something different? Coating eyelashes means mascara therefore applicants’ are requested to provide the examiner the product name for “making up eyelashes”. What is meant by “composition to be applied over eyelash makeup”? What is this product sold in the cosmetic industry? What is meant by “composition for treating eyelashes”? The claims are

so ambiguous, the metes and bounds of these expressions cannot be determined from the specification since specification only teaches mascara (coating eyelashes).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31-44, 46 and 50-54 and 56 rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 7,129,276 ('276).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See example 2 for the claimed species and see example 5 for the lipstick formulation. Hydrogenated isoparaffin reads on the claimed fatty phase (oil). Stearyl acrylate/NVP is the species belonging to crystalline polymer (specific compound). Example 5 has no water and this reads on claim 43. See col.12, lines 43-46 for fatty phase weight. See col.14, line 36 for water and this reads on claim 44 and 46. See col.13, lines 19-43 for pigments and this reads on claims 50-52. See paragraph bridging col.s 15-16 for fillers of claim 53. See col.16, lines 43-49 for



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claim 54 and making up (make up) for keratin substance reads on claim 56. Since the semi crystalline polymer species is same the claimed property claimed in claims 32-34, 37 is inherent since the compound and its properties are inseparable. It is true for claimed property of oil claimed in claim 41. Note that hydrogenated isoparaffin belongs to oil.

Claims 31-42, 44-47 and 50-54 are rejected under 35 U.S.C. 102(e) as being anticipated by PGPUB 2003/0165451 A1.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See example 2 for the claimed species and see example 5 for the care cream. Silicone oil or Isohexadecane or Parleam reads on the oil. Stearyl acrylate/NVP is the species belonging to crystalline polymer (specific compound). Example 5 has glycerol and it reads on claims 44-46 hydrophilic organic solvent, which is polyols having 2 carbon atoms and the amount is within the claimed range and it reads on claim 43. See paragraph 92 for fatty phase weight. See col.14, line 36 for water and this reads on claim 44 and 46. See paragraph 129 for dyestuff and this reads on colorant and dyes of claims 50-52. See paragraph 129 for remaining ingredients of claim 53. See paragraph 135 and 141 for claim 54. Since the semi crystalline polymer species is same the claimed property claimed in claims 32-34, 37 is inherent since the compound and its properties

are inseparable. The same is true for claimed property of oil claimed in claim 41. Note that hydrogenated isoparaffin belongs to oil.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of patent '276 or PGPUB '451 taken individually and combined with U. S. Patent 5,876,704('704).

Patent '276 or PGPUB '451 do not teach the limitation of claims 47-48 drawn to film former or specific film former and the amount of film former present in the cosmetic compositions. However patent '704 teaches cosmetic composition useful as mascara using the specific film-forming polymer. See the abstract. Patent at col.5, ll 27-60 teaches film forming polymers and claimed species of film forming polymers like cellulose polymers, vinyl polymers

and polyester film formers. Patent at col. 7 teaches various additives that can be added and this includes fillers. See also examples.

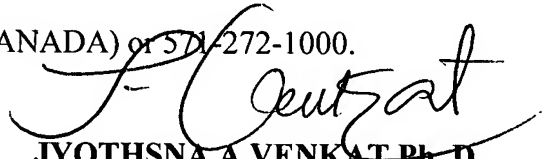
Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '276 or PGPUB and add the film-forming polymer into the compositions. One of ordinary skill in the art would be motivated to add the film former with the reasonable expectation of success that the compositions have the additional advantage of forming film and film forming polymers are conventionally used in lipstick and mascara so that the compositions would not smudge. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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